

D. Remarks:

Upon entry of the present amendments, claims 32 and 34-35 are pending in the application. ~~Claim 34 has been amended to more particularly define the subject matter of the~~ invention. Support for the amendment can be found in the substitute specification, *e.g.*, at least at page 21, lines 13-14. Claim 33 has been canceled herein. No new matter has been added.

Priority

The Examiner objects to the previous amendment filed on October 10, 2001, which added the "Related Applications" section. Specifically, the Examiner requires that the status of the prior applications also be included.

Applicants have amended the Related Applications section previously submitted on October 10, 2001 to include the status of the applications, as required by 37 C.F.R. §§ 1.78(a)(2) and (a)(5).

Accordingly, the objection should be withdrawn.

Claim Objections

The Examiner objects to the claims for being misnumbered as claims 51-53. Applicants have renumbered the claims 32-34, thereby correcting this oversight. Upon entry of this amendment, claims 32 and 34 are currently pending in the application.

Accordingly, the objection should be withdrawn.

Specification

The Examiner objects to the Abstract of the disclosure for two reasons. First, the Examiner indicates that the Abstract was not presented on a separate sheet in the amendment filed on October 10, 2001. Second, according to the Examiner, the Abstract introduces new matter into the disclosure by reciting the term "nucleic acids" in place of the term "cDNA libraries," as recited by the parent application, U.S.S.N. 08/484,203, filed June 7, 1995.

Applicants have herein amended the specification to include the Abstract of the disclosure as a separate sheet. Moreover, Applicants have amended the Abstract previously submitted on October 10, 2001 to be identical to that of the parent application.

Accordingly, these objections should be withdrawn.

Inventorship

The Examiner objects to the supplemental oath submitted on October 10, 2001 as non-compliant with 37 C.F.R. § 1.48(b). Applicants submit herewith a copy of the Petition for Correction of Inventorship for the present application, concurrently filed with the Petitions Office on this date.

As indicated in the Petition, although Samuel Weiss, Brent A. Reynolds, E. Edward Baetge, and Joseph P. Hammang were properly named as co-inventors of the application as filed, Drs. Baetge and Hammang are not co-inventors of the subject matter in the currently pending claims. Thus, Applicants request that the inventorship of the above-identified application be changed upon grant of the Rule 48(b) petition.

Double Patenting

Statutory-type Double Patenting

The Examiner rejects claim 33 under 35 U.S.C. § 101 as claiming the same invention recited by claim 5 of U.S. Patent No. 6,399,369 B1 ("the '369 Patent"). According to the Examiner, claim 33 of the present application and claim 5 of the '369 Patent are of identical scope because they recite cDNA libraries from human neurospheres.

Applicants have canceled claim 33 herein. Accordingly, the rejection is moot and should be withdrawn.

Obviousness-type Double Patenting

The Examiner rejects claims 32 and 34 under the judicially created doctrine of obviousness-type double patenting. According to the Examiner, claims 1 and 5 of the '369 Patent are not patentably distinct from claims 32 and 34 of the instant application.

Applicants file concurrently herewith a terminal disclaimer under 37 C.F.R. § 1.321(c), along with the corresponding fee. Accordingly, this rejection should be withdrawn.

Rejection under 35 U.S.C. § 112, ¶ 1.

The Examiner rejects claim 34 under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. According to the Examiner, the recitation of “wherein the undifferentiated neural cells are obtained from the frontal lobe, conus medularis, thoracic spinal cord, brain stem, hypothalamus, lateral ventricles of the forebrain” constitutes new matter as no proper antecedent basis or conception exists in the specification. *See* Office Action, at page 5. The Examiner further notes that “page 21 (line 14) states ‘[n]eural stem cells have been isolated from a variety of adult CNS ventricular regions...’” (emphasis added).

To facilitate the prosecution of this application, Applicants have amended claim 34 to recite that the undifferentiated cells are obtained from CNS ventricular regions, as suggested by the Examiner. Support for this amendment is found at least on page 21, lines 3-20 of the substitute specification. Thus, Applicants believe the rejection for lack of written description is overcome, and this rejection should be withdrawn.

The Examiner further rejects claim 34 under 35 U.S.C. § 112, first paragraph for failing to reasonably provide enablement for making cDNA libraries from regions of the adult brain that do not contain multipotent neural stem cells. *See* Office Action at p. 6.

As noted above, in order to facilitate prosecution, Applicants have amended claim 34 to specify that the undifferentiated neural cells are obtained from “CNS ventricular regions.” The specification makes clear that ventricular tissue is a preferred neural tissue for obtaining multipotent neural stem cells. *See* substitute specification, page 21, lines 3-5. The specification also teaches that neural stem cells have been isolated from a variety of adult CNS ventricular regions. *See* substitute specification at p. 21, lines 13-14; and p. 24, lines 18-21.

Accordingly, Applicants submit that claim 34, as amended herein, is commensurate in scope with the teachings of the specification. Therefore, one of ordinary skill in the art would be able to make and use the claimed invention without undue experimentation.

Thus, this rejection should be withdrawn.

Rejection under 35 U.S.C. § 112, ¶ 2.

The Examiner also rejects claim 34 under 35 U.S.C. § 112, second paragraph as indefinite. According to the Examiner, the recitation of “wherein undifferentiated neural cells are obtained from . . . lateral ventricles of the forebrain” is indefinite because tissue cannot be obtained from a cavity, which refers to “open space” by definition. *See* Office Action, page 7.

Claim 34 has been amended to specify that the undifferentiated neural cells are obtained from CNS ventricular regions. Support for this amendment is found at least on page 21, lines 13-14 of the substitute specification. Therefore, Applicants believe that this amendment overcomes the Examiner’s rejection for indefiniteness.

Accordingly, this rejection should be withdrawn.

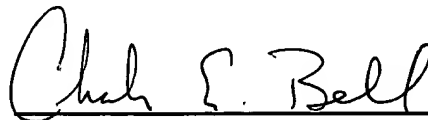
E. Conclusion:

Applicants submit that this paper is fully responsive and that the application is in condition for allowance. Such action is respectfully requested. Should any questions or issues arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

No additional fees are believed due in connection with this paper. However, the Commissioner is authorized to charge any additional fees that may be due, or to credit any overpayment, to Deposit Account No. 50-0311, Reference 17810-705DIV11 CON (CTI-N5 DIV11 CON).

Respectfully submitted,

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